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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,153	01/24/2004	Amanda K. Bridges	2003-0535.02	8151
21972 7590 09/28/2007 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			EXAMINER MCLEAN, NEIL R	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 09/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/764,153	Applicant(s) BRIDGES ET AL.	
	Examiner Neil R. McLean	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/18/2004</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5-6, 9-12, 19-20, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al. (US 6,618,749).

Regarding Claim 1:

Saito et al. discloses a method of using a print device (e.g., Figure 2), comprising the steps of:

transmitting (Column 3, lines 37-40) an email over a network (e.g., Internet 13 in Figure 1); and

generating a transmission report (e.g., Figure 4; Column 5, lines 20-42) at said print device, said transmission report including an indication of success or failure (Column 2, lines 27-31) of said email transmission (Column 4, lines 22-24).

Regarding Claim 5:

Art Unit: 2625

The method of claim 1, wherein said transmission report includes upon said failure at least one of a primary SMTP (Column 4, lines 15-18) gateway IP address, an indication of said failure (Column 2, lines 27-31), a number of tries of said transmission, and a mail server response.

Regarding Claim 6:

The method of claim 1, wherein said email includes an attachment (Column 7, lines 9-12).

Regarding Claim 9:

The method of claim 6, wherein said attachment comprises one of a scan job (Scanner 26 in Figure 2, Column 4, lines 1-2) and a fax job (Fax 28 in Figure 2; Column 4, lines 3-4) associated with said email (Column 3, lines 37-40).

Regarding Claim 10:

The method of claim 9, wherein said transmission report comprises information relating to said attachment, including at least one of a file name, data format (Figure 7, "This message is accompanied by TIFF = Format Image Data"), and image resolution.

Regarding Claim 11:

The method of claim 1, wherein said generating step includes the substep of printing said transmission report (Column 3, lines 41-45) with said print device.

Regarding Claim 12:

The method of claim 1, wherein said transmitting step includes transmitting said email using one of said print device (e.g., Fax 11 in Figure 1) and a computer (PC 12 in Figure 1) attached to said network (Column 3, lines 37-40).

Regarding Claim 19:

Saito et al. discloses a method of using a print device (e.g., Figure 2), comprising the steps of:

transmitting an email over a network (e.g., Internet 13 in Figure 1); and  
generating a transmission report (e.g., Figure 4; Column 5, lines 20-42) at said print device, said transmission report including information (Column 2, lines 27-31) pertaining to said email (Column 4, lines 22-24).

Regarding Claim 20:

The method of claim 19, wherein said transmission report includes an indication of success or failure (Column 2, lines 27-31) of said email transmission.

Regarding Claim 22:

The method of claim 19, wherein said automatically generating step includes the substep of printing said transmission report with said print device (Column 3, lines 41-45).

Regarding Claim 23:

The method of claim 19, wherein said transmitting step includes transmitting said email using one of said print device (e.g., Figure 2) and a computer (PC 12 in Figure 1) attached to said network (Column 3, lines 37-40).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-4, 7-8, 13-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. in view of Irlam et al. (6,650,890).

Regarding Claim 2:

Saito et al. discloses the method of claim 1, wherein said transmission report includes an image associated with said email upon a successful transmission of said email (Column 2, lines 27-31), and said transmission report does not include an image associated with said email upon an unsuccessful transmission (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 7, lines 9-12).

Saito et al. does not disclose expressly where the transmission report includes a thumbnail image.

Irlam et al. in the same field of endeavor of displaying graphical information, discloses a thumbnail image to identify a file (Column 5, lines 48-57; Column 6, lines 55-59).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a thumbnail image to represent a files contents.

The suggestion/motivation for doing so is to reduce a significant part of an image instead of the full size and still be recognizable. It offers the viewer an indication of what is contained in the image.

Therefore, it would have been obvious to combine Irlam et al.'s thumbnail image representation with the internet fax and email method of Saito et al. to obtain the invention as specified in Claim 2.

Regarding Claim 3:

The method of claim 2, wherein said image comprises an image associated with said email (Saito et al.; Column 7, lines 9-12).

Note: Please see Claim 1 rejection.

Regarding Claim 4:

The method of claim 3, wherein said image comprises one of a scan job (Saito et al.: Scanner 26 in Figure 2, Column 4, lines 1-2) and a fax job (Fax 28 in Figure 2;

Column 4, lines 3-4) associated with said email (Column 3, lines 37-40).

Regarding Claim 7:

The method of claim 6, wherein said transmission report includes a image of said attachment (Saito et al. Column 7, lines 9-12).

Note: Please see Claim 1 rejection.

Regarding Claim 8:

The method of claim 6, wherein said transmission report includes a image of said attachment upon a successful transmission (Saito et al.: Column 2, lines 27-31) of said email, and said transmission report does not include a image of said attachment upon an unsuccessful transmission (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 7, lines 9-12).

Note: Please see Claim 1 rejection.

Regarding Claim 13:

Saito et al. discloses a method of using a print device (e.g., Figure 2), comprising the steps of:

transmitting an email (Column 3, lines 37-40); and

generating a transmission report (e.g., Figure 4) at said print device, said transmission report including an image associated with said email upon a successful



transmission (Column 2, lines 27-31) of said email, and said transmission report not including an image associated with said email upon an unsuccessful transmission (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 6, lines 7-13).

Saito et al. does not disclose expressly where the transmission report includes a thumbnail image.

Irlam et al. in the same field of endeavor of displaying graphical information, discloses a thumbnail image to identify a file (Column 5, lines 48-57; Column 6, lines 55-59).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a thumbnail image to represent a files contents.

The suggestion/motivation for doing so is to reduce a significant part of an image instead of the full size and still maintain recognizability. It offers the viewer an indication of what is contained in the image.

Therefore, it would have been obvious to combine Irlam et al.'s thumbnail image representation with the internet fax and email method of Saito et al. to obtain the invention as specified in Claim 13.

Regarding Claim 14:

The method of claim 13, wherein said thumbnail image comprises an image associated with said email (Saito et al.; Column 7, lines 9-12).

Note: Please see Claim 13 rejection.

Regarding Claim 15:

The method of claim 14, wherein said image comprises one of a scan job (Saito et al.: Scanner 26 in Figure 2, Column 4, lines 1-2) and a fax job (Fax 28 in Figure 2; Column 4, lines 3-4) associated with said email (Column 3, lines 37-40).

Note: Please see Claim 13 rejection.

Regarding Claim 16:

The method of claim 15, wherein said transmission report includes at least one image associated with said email upon a successful transmission (Saito et al.; Column 2, lines 27-31) of said email, each said thumbnail image corresponding to a different page of said scan job or fax job.

Note: Please see Claim 13 rejection.

Regarding Claim 17:

The method of claim 13, wherein said generating step includes the substep of printing said transmission report with said print device (Saito et al.; Column 3, lines 41-45).

Regarding Claim 18:

The method of claim 13, wherein said transmitting step includes transmitting said email using one of said print device (Saito et al.: Fax 11 in Figure 1) and a computer (PC 12 in Figure 1) attached to said network (Col 3, lines 37-40).

Regarding Claim 21:

The method of claim 20, wherein said transmission report includes a image associated with said email upon a successful transmission of said email (Column 2, lines 27-31), and said transmission report does not include a image associated with said email upon a failure (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 6, lines 7-13).

Note: Please see Claim 13 rejection.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eguchi (US 7,023,586) discloses a facsimile server connected to a mail server and a client over a network, and capable of sending and receiving an e-mail via the mail server.

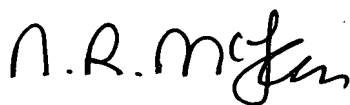
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is 571.

Art Unit: 2625

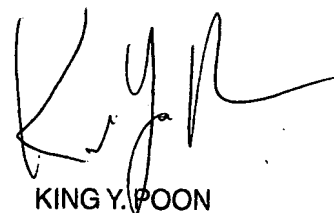
270.1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571.272.7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Neil R. McLean  
09/21/2007



KING Y. POON  
SUPERVISORY PATENT EXAMINER